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10/040,176	10/25/2001	Thomas J. Perkowski	100-010USANA0	3645

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EXAMINER

HAYES, JOHN W

ART UNIT PAPER NUMBER

3621

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/040,176

Applicant(s)

PERKOWSKI, THOMAS J.

Examiner

John W Hayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Applicant has canceled all pending claims (1-41) and added new claims 42-55 in the amendment filed 19 July 2004. Thus, claims 42-55 are the only claims that remain pending and are presented for examination.

Response to Arguments

2. Applicants arguments filed 19 July 2004 have been fully considered but are not found to be persuasive. Applicant argues that the references do not disclose "actively managing consumer product information for registered consumer products by updating a relational database". In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., actively managing consumer product information for registered consumer products by updating a relational database) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claim 42, at least, only specifies that a data link is "created and maintained". Examiner notes that creating and maintaining a link as recited in the claims is entirely different than actively managing information by updating a relational database. The term maintain is merely defined as "to keep in an existing state" and does not correspond to "actively managing by updating the information". Furthermore, Hudetz discloses a database for storing links to product information (Figures 1 and 4; Col. 7, lines 1-42). A database inherently has the capability of being updated or changed so the information stored therein reflects the current status or current information.

Other Remarks

3. In the previous Office Action, Examiner indicated that an inventor name search was conducted which returned a list of 53 applications that appear to be related to the current invention. Examiner requested

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applicant's assistance in identifying all related pending, allowed or issued applications with similar claim language so that all potential Double Patenting issues could be properly identified and addressed. It appears that applicant has ignored this request since no information concerning related applications that are pending, allowed or issued was provided to the examiner. Examiner states, once again, that this information is requested of the applicant in order to properly address all the double patenting issues. Examiner further notes that this application will not be allowed until all these issues are properly addressed.

Specification

4. The disclosure is objected to because it contains embedded hyperlinks and/or other form of browser-executable code. See Specification, page 6, line 3; page 7, line 19; page 32, line 16; page 35, lines 14 and 23 and page 86, line 22. The attempt to incorporate subject matter into the patent application by reference to a hyperlink and/or other forms of browser-executable code is considered to be an improper incorporation by reference. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01(p), paragraph I regarding incorporation by reference.
5. The disclosure is objected to because Figure 3B and 3C are not included in the List of Figures. Also, there is no Figure 3D as referenced by the specification (Page 23). Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 42-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Hudetz et al*, U.S. Patent No. 5,978,773 in view of *Blinn et al*, U.S. Patent No. 5,897,622.

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As per **Claims 42 and 44-46**, Hudetz et al disclose method of delivering manufacturer-specified consumer product information to consumers in the marketplace, said method comprising the steps of:

(a) for a plurality of UPN-labeled consumer products offered for sale within the marketplace, having the manufacturer of said plurality of UPN-labeled consumer products or an agent thereof, access a relational database and store therein, information elements representative of (Figures 1 and 4; Col. 7, lines 1-42):

(1) a plurality of universal product numbers (UPNs) assigned to a plurality of UPN-labeled consumer products manufactured by said manufacturer and registered with said relational database (Figure 4; Col. 7, line 1-Col. 8 line 10), and

(2B) a product description (PD) symbolically linked to each said UPN (Figure 4; Col. 7, line 1-Col. 8 line 10), and

(2C) a plurality of uniform resource locators (URLs) symbolically linked to each said UPN (Figure 4; Col. 7, line 1-Col. 8 line 10),

wherein each said URL specifies the location of an information resource located on the Internet and related to one of said plurality of UPN-labeled consumer products registered with said relational database by said manufacturer (Figure 4; Col. 7, line 1-Col. 8 line 10), and

wherein a UPN/PD/URL data link is created and maintained in said relational database for each said UPN-labeled consumer product registered with said relational database by the manufacturer and/or agent thereof (Figure 4; Col. 7, line 1-Col. 8 line 10);

(b) operably connecting an Internet information server to the infrastructure of the Internet and to said relational database server, so as to enable said Internet information server to service a request made by an Internet-enabled consumer product information kiosk, for information on the Internet about one of said plurality of UPN-labeled consumer products registered with said relational database by said manufacturer (Figure 1; Col. 7, lines 42-50);

(c) operably connecting one or more Internet based product information servers, to the infrastructure of the Internet, in which information resources related to one or more of said plurality of UPN-labeled consumer products and are stored at said plurality of URLs (Figure 1; Col. 7, lines 42-50);

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(d) operably connecting a plurality Internet-enabled client computers to the infrastructure of the Internet (Col. 8, lines 20-25);

(e) transmitting from at least one of said Internet-enabled client computers a request for consumer product information on the Internet about a UPN-labeled consumer product registered with said relational database, wherein each said request may include either the UPN and/or PD symbolically linked to the UPN assigned to a registered UPN-labeled consumer product on which consumer product information on the Internet is being sought by a consumer within said marketplace (Figure 1; Col. 5, lines 13-20 and 48-55; Col. 8, lines 21-46);

(f) receiving at said Internet information server, the request transmitted by said Internet enabled client computer, and recovering the UPN and/or PD contained in said request so as to enable said Internet information server to access said plurality of URLs symbolically linked to the UPN and/or PD and stored in said relational database, and then transmit said accessed plurality of URLs to said Internet-enabled client computer for use in accessing information resources stored in said Internet-based product information servers, at said URLs (Col. 8 line 29-Col. 9 line 22)

Hudetz, however, fails to specifically disclose that the information stored includes trademark information. Blinn et al disclose an electronic shopping and merchandising system that provides great flexibility for a merchant to adapt the system to their existing business practices, promotions and databases. *Blinn et al* teaches a method that allows merchants to insert, delete and update remote databases of product information such as a product name which may be considered to be a trademark (Abstract, Col. 2, lines 10-28; Col. 6, lines 31-36; Col. 9, lines 60-63; Col. 19, lines 40-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of *Hudetz et al* and incorporate the ability to enable the manufacturer or merchant of the products to access a remote database over the Internet and manage and update the information stored in the database, including trademark information. It is well known in the database arts that information stored in databases periodically needs to be updated dynamically in order that the information continue to be current. By enabling manufacturers to update information in their remote databases, information related to products that consumers are interested in can be updated as necessary.

As per **Claim 43**, Hudetz et al further disclose wherein at least one of said Internet-based client computers comprises an Internet-enabled consumer product information kiosk installed within said marketplace, wherein said Internet-enabled consumer product information kiosk has (i) an automatic bar code symbol reader for reading the UPN labels on said plurality of UPN-labeled consumer products and entering UPN information into said Internet-enabled consumer product information kiosk (Figures 1-2 and 8), (ii) a touch type data entry and display screen for entering PD related information into said Internet-enabled consumer product information kiosk and displaying consumer product information resources accessed from Internet-based information servers (Figure 6 and Col. 5, lines 25-30), and (iii) UPN and PD directed modes of consumer product information search operation (Col. 7, lines 1-42).

As per **Claim 47**, Hudetz et al further disclose wherein said manufacturer or an agent thereof uses an Internet-enabled browser to access said relational database, and store UPN/PD/URL information links therein (Figure 1; Col. 7, line 1-Col. 8 line 10).

As per **Claim 48**, Hudetz et al further disclose wherein said automatic laser scanning bar code symbol reader is used to read the UPN-label on at least one of said plurality of UPN-labeled consumer products (Figures 1-2 and 8).

As per **Claims 49-50, 52-53 and 55**, Hudetz et al disclose system for delivering manufacturer-specified consumer product information to consumers in the marketplace, said method comprising the steps of:

(a) a relational database accessible by the manufacturer of a plurality of UPN-labeled consumer products offered for sale within a retail store environment, or by an agent thereof, for storing therein information elements representative of (Figures 1 and 4; Col. 7, lines 1-42):

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(1) a plurality of universal product numbers (UPNs) assigned to a plurality of UPN-labeled consumer products manufactured by said manufacturer and registered with said relational database (Figure 4; Col. 7, line 1-Col. 8 line 10), and

(2B) a product description (PD) symbolically linked to each said UPN (Figure 4; Col. 7, line 1-Col. 8 line 10), and

(2C) a plurality of uniform resource locators (URLs) symbolically linked to each said UPN (Figure 4; Col. 7, line 1-Col. 8 line 10),

wherein each said URL specifies the location of an information resource located on the Internet and related to one of said plurality of UPN-labeled consumer products registered with said relational database by said manufacturer (Figure 4; Col. 7, line 1-Col. 8 line 10), and

wherein a UPN/PD/URL data link is created and maintained in said relational database for each said UPN-labeled consumer product registered with said relational database by the manufacturer, and offered for sale in the marketplace (Figure 4; Col. 7, line 1-Col. 8 line 10);

(b) an Internet information server, operably connected to the infrastructure of the Internet and to said relational database server, so as to enable said Internet information server to service a request made by an Internet-enabled consumer product information kiosk, for information on the Internet about one of said plurality of UPN-labeled consumer products registered with said relational database by said manufacturer (Figure 1; Col. 7, lines 42-50);

(c) a plurality of Internet-based product information servers, each operably connected to the infrastructure of the Internet and storing information resources located at one or more of said plurality of URLs stored in said relational database, and being related to one or more of said plurality of UPN-labeled consumer products (Figure 1; Col. 7, lines 42-50);

(d) a plurality of Internet-enabled client computers installed within said marketplace, each being operably connected to the infrastructure of the Internet and being capable of transmitting a request therefrom for information resources on the Internet about a UPN-labeled consumer product registered with said relational database (Figure 1; Col. 5, lines 13-20 and 48-55; Col. 8, lines 20-46);

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(e) wherein each said request may include either the UPN and/or PD symbolically linked to the UPN assigned to a registered UPN-labeled consumer product on which consumer product information on the Internet is being sought by a consumer within said retail store environment (Figure 1; Col. 5, lines 13-20 and 48-55; Col. 8, lines 21-46);

(f) wherein each request transmitted by said Internet enabled consumer product information kiosk is received by said Internet information server, and recovering the UPN and/or PD contained in said request so as to enable said Internet information server to access said plurality of URLs symbolically linked to the UPN and/or PD and stored in said relational database, and then transmit said accessed plurality of URLs to said Internet-enabled client computer for use in accessing information resources stored in said Internet-based product information servers, at said URLs (Col. 8 line 29-Col. 9 line 22)

Hudetz, however, fails to specifically disclose that the information stored includes trademark information. Blinn et al disclose an electronic shopping and merchandising system that provides great flexibility for a merchant to adapt the system to their existing business practices, promotions and databases. *Blinn et al* teaches a method that allows merchants to insert, delete and update remote databases of product information such as a product name which may be considered to be a trademark (Abstract, Col. 2, lines 10-28; Col. 6, lines 31-36; Col. 9, lines 60-63; Col. 19, lines 40-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of *Hudetz et al* and incorporate the ability to enable the manufacturer or merchant of the products to access a remote database over the Internet and manage and update the information stored in the database, including trademark information. It is well known in the database arts that information stored in databases periodically needs to be updated dynamically in order that the information continue to be current. By enabling manufacturers to update information in their remote databases, information related to products that consumers are interested in can be updated as necessary.

As per **Claim 51 and 54**, Hudetz et al further disclose wherein at least one of said Internet-based client computers comprises an Internet-enabled consumer product information kiosk installed within said marketplace, wherein said Internet-enabled consumer product information kiosk has (i) an automatic bar

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code symbol reader for reading the UPN labels on said plurality of UPN-labeled consumer products and entering UPN information into said Internet-enabled consumer product information kiosk (Figures 1-2 and 8), (ii) a touch type data entry and display screen for entering PD related information into said Internet-enabled consumer product information kiosk and displaying consumer product information resources accessed from Internet-based information servers (Figure 6 and Col. 5, lines 25-30), and (iii) UPN and PD directed modes of consumer product information search operation (Col. 7, lines 1-42).

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 42-55 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,631,357 in view of Hudetz et al, U.S. Patent No. 5,978,773. Although the conflicting claims are not identical, they are not patentably distinct from each other. Claims 42 and 49 recite substantially the same features as claims 1-4 of the patent, however, claims 42 and 49 of the application eliminate recitations related to a plurality of Internet based product-information servers, automatically analyzing the requests and contacting the manufacturer and soliciting the manufacturer to register the consumer product with the database. The courts have held that elimination of an element and its function is not an inventive step. *In re Karlson*, 153 USPQ 184 (CCPA 1963). Therefore, the elimination steps and structure would have been obvious to a person of ordinary skill in the art.

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Claims 43-48 and 50-55 depend from claims 42 and 55 and are, therefore, rejected under the same rationale.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

12. The prior art previously made of record and not relied upon is considered pertinent to applicant's disclosure.

- Wellner discloses an apparatus and method for enabling a user to receive an electronic multimedia service based upon scanning an object and requesting information about the object

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- Cragun et al disclose a client computer with a scanner capable of scanning objects wherein the computer translates a code on the object into a URL for receiving information related to the object
- Tracy et al disclose a portable shopping system including a scanner for scanning objects and providing marketing information to promote the sale of products. Tracy et al also discloses a card reader linked to the customer service console
- Shachar discloses a system for scanning bar codes on products and accessing information regarding the product from the Internet. Shachar also discloses the use of the FTP protocol for downloading or uploading binary files over the Internet
- Knowles discloses a system and method for composing URL-encoded bar code symbols specifying the location of Internet-based information resources on the Internet
- Browning discloses a handheld scanner and accompanying remote access agent for accessing information on the Internet regarding products of interest
- Namekata et al [Japanese Abstract] discloses a method to obtain information about products by scanning a bar code from a home terminal and retrieving information from a data communication network.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

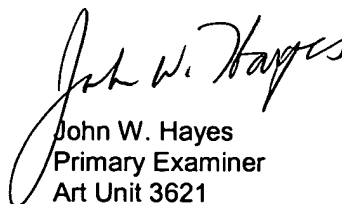
***Commissioner of Patents and Trademarks
Washington D.C. 20231***

or faxed to:

(703) 872-9306 [Official communications; including
After Final communications labeled
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(703) 746-5531 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington,
VA, 7th floor receptionist.


John W. Hayes
Primary Examiner
Art Unit 3621

October 14, 2004